

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TEDDY L. STEWART

Appeal No. 98-1207
Application No. 08/420,648¹

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17 through 41, which are all of the claims pending in this application.

¹ Application for patent filed April 12, 1995. According to the appellant, the application is a continuation of Application No. 08/019,571, filed February 18, 1993, now U.S. Patent No. 5,421,108, which was a continuation-in-part of Application No. 07/765,537, filed September 25, 1991, now abandoned.

Appeal No. 98-1207
Application No. 08/420,648

We AFFIRM, however, for reasons explained *infra*, we
denominate part of our affirmance a new ground of rejection
under 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a high volume pipe padding machine. An understanding of the invention can be derived from a reading of exemplary claim 17, which appears in the appendix to the appellant's brief.²

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Downey 1972	3,701,422	Oct. 31,
Gellhaus 1979	4,162,968	July 31,
Bishop et al. 1990 (Bishop)	4,912,862	April 3,

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² We note that the text of claim 17 in the appendix of the brief is not a true copy of pending claim 17 as pointed out by the examiner on page 3 of the answer. However, we, like the examiner, will treat claim 17 as having been amended to read as presented in the appendix of the brief. The appellant should ensure that claim 17 is properly amended in any further prosecution before the examiner.

As an initial matter, our view of the record indicates that two rejections in addition to the two rejections under 35 U.S.C. § 103 discussed infra have been made by the examiner and never withdrawn.

The double patenting rejection

In the first Office action (Paper No. 5, mailed August 21, 1995, pp. 6-7), the examiner rejected claims 1 and 17 through 41 under the judicially created doctrine of double patenting over claims 1 through 10 of U.S. Patent No. 5,421,108 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The appellant responded to this rejection (Paper No. 6, filed February 23, 1996, p. 5) by stating that "a suitable disclaimer is being prepared and will be filed shortly." In the final rejection (Paper No. 7, mailed May 10, 1996, p. 2), the examiner noted that the appellant will be submitting a disclaimer in response to the double patenting rejection made in the first Office action.

Given that no terminal disclaimer has as yet been filed by the appellant, it is our determination that the double patenting rejection made in the first Office action is before us in this appeal. Since the appellant has not argued this rejection in the brief and no terminal disclaimer has yet been submitted to overcome this rejection, we summarily sustain the rejection of claims 17 through 41 under the judicially created doctrine of double patenting.

We denominate our affirmance of this ground of rejection a new ground of rejection under 37 CFR § 1.196(b) since the examiner failed to specifically include this ground of rejection in the final rejection.

The indefiniteness rejection

In the final rejection (p. 2), the examiner rejected claims 25 through 31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The appellant responded to this rejection in the brief (pp. 2, 4 and 7) by stating that the unentered amendment after final would overcome this rejection. In the answer (p. 6), the examiner assumed it was the appellant's intention to correct claim 25 per the unentered amendment after final to overcome the rejection of claims 25 through 31 under 35 U.S.C. § 112, second paragraph.

Since no further amendment has been filed by the appellant, it is our determination that the rejection under 35 U.S.C. § 112, second paragraph, made in the final rejection is before us in this appeal. Since no amendment has yet been submitted and entered to overcome this rejection, we summarily sustain the rejection of claims 25 through 31 under 35 U.S.C. § 112, second paragraph.

The obviousness rejections

Claims 17 through 21, 23, 24, 32, 33, 35 through 39 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Downey in view of Bishop.

Claims 22, 34 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Downey in view of Bishop and Gellhaus.

In reaching our decision in this appeal on the rejection of claims 17 through 24 and 32 through 41 under 35 U.S.C. § 103, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant in the brief (Paper No. 12, filed March 17, 1997) and reply brief (Paper No. 14, filed August 5, 1997) and the examiner in the answer (Paper No. 13, mailed June 5, 1997). Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is sufficient to establish obviousness with respect to claims 17 through 24 and 32 through 41. Accordingly, we will sustain the examiner's rejections of claims 17 through 24 and 32 through 41 under 35 U.S.C. § 103. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary

skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Downey discloses an earth moving vehicle including a scraper for collecting rocky earth and other native material (Figure 2) to be carried upwardly by an endless paddle elevator (Figure 4) across a bar-type separating means (i.e., a grizzly) for separating the material into fines and larger aggregates or tailings. The fines drop through the separator onto a continuously moving transverse conveyor adapted to discharge the fines along a line parallel to the line of vehicle movement and spaced laterally therefrom, for example

in a partially filled trench for a pipeline or the like (Figure 1). The tailings are simultaneously discharged onto a second transversely extending continuously moving conveyor to be discharged along a longitudinal ridge, preferably on the opposite side of the vehicle from the trench being filled, and extending parallel to movement of the vehicle (Figure 3).

As shown in Figures 1, 4 and 5 of Downey, the earth moving vehicle 10 includes a conventional motor driven tractor 20 pulling a scraper body 21 (base platform) having a scraper blade 22 for collecting native material 14 from the ground 11 to be moved by the paddles 23 of a motor driven endless elevator 24 into a container 25. A separating means 40 serves to receive the native material 14 from the endless elevator 24 and separate the native material 14 into fines 15, being smaller than a predetermined size and into tailings 16, being larger than the predetermined size. A plate 41 is mounted in the container 25 and extends upwardly and rearwardly from the scraper blade 22 parallel to elevator 24 and spaced therefrom by the height of a paddle 23. Plate 41 terminates rearwardly

at the forward end of one of a pair of funnel plates 42 located in the fore section 27 of the container 25. The funnel plates 42 are inclined downwardly and toward one another, terminating at a lower opening 43. Rearwardly and above the juncture of plates 41 and 42 there is provided a grizzly 44. Grizzly 44 includes a series of spaced parallel front bars 45 rising to an apex from which spaced fanned rear bars 46 extend downwardly and rearwardly.

Bishop discloses a mobile backfilling machine wherein raw materials located adjacent an excavated trench are picked up, graded and delivered to the open trench in an order of size grading from finest to coarsest, thereby providing a fine material padding for a product which has been placed into the trench. Bishop teaches that the machine is intended for operation along a berm line 10, composed of excavated materials from trench 44 and which typically lies parallel to and adjacent such excavated trench 44 (see Figure 3), on ground grade 12.

As shown in Figures 2-4 of Bishop, conveyor 16 lifts the raw material upward and to the rear of the machine. At the after end of conveyor 16, the raw material is gravity transferred to grizzly bars 46 (a multiple tined fork arrangement) used to provide a first very course screening of the raw material to remove larger rock size portions. The coarsest material 48 rolls off the rear of grizzly 46 and is fed by gravity to conveyor belt 50. Coarse screen 18 and fine screen 20 are located just below grizzly 46. Collector plate 22 is located just below fine screen 20. Screens 18 and 20 and collector plate 22 are assembled as a unit. An eccentric weight 24 is rotatably mounted below and connected to collector plate 22 to impart a shaking motion to the unit comprising screens 18 and 20 and collector plate 22. Thus, materials which are small enough to pass through the bars of grizzly 46 fall on screen 18. The shaking motion of eccentric weight 24 urges these materials to flow downward, either toward the front of the machine over the top of screen 18, or through the coarse screen 18 to finer screen 20. The larger particles 36 flow to the forward end of screen 18 and drop off onto the ground as shown. The finer

materials which fall through screen 18 pass onto finer screen 20. Here, again, the coarser materials 34 are retained above screen 20 while the finer materials 32 pass through to collector plate 22. The relatively coarser materials 34 on the top of screen 20 are urged to flow downward toward the front of the machine where they are collected on conveyor belt 30, which carries them to the right of the machine and into trench 44. The finer materials which pass through screen 20 are collected by collector plate 22 and are urged to flow downward, toward the front of the machine, to conveyor belt 26. Conveyor belt 26 conveys the finest materials to the right of the machine where they are transferred by means of gravity to conveyor belt 28. Conveyor 28 carries the finest material, above conveyor 30, to the front of the machine for padding the trench 44. In operation, then, conveyor 28 places the finest materials into trench 44, first. Conveyor 30 follows with a coarser material and the coarsest materials are deposited into the trench, last, or onto the ground, according to the way the machine is set up.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Downey and the independent claims rejected under 35 U.S.C. § 103 (i.e., claims 17, 32 and 37), it is our opinion that the only differences are: (1) the screen vibrator unit as recited in claim 17, (2) the screen vibrator unit as recited in claim 32, and (3) the screen unit as recited in claim 37.

In applying the above-noted test for obviousness, we reach the same conclusion as the examiner (answer, p. 4) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Downey to have a screen vibrator unit as suggested and taught by Bishop in order to provide a means of further separating out finer materials from the material which passes through the grizzly bars of Downey.

The appellant has not contested the obviousness of modifying Downey based upon the teachings of Bishop.

The appellant's argument (brief, pp. 6-7 and reply brief, pp. 1-2) for patentability of claim 17 is that Downey lacks a conveyor positively conveying material over the grizzly bars. We do not agree. The plurality of grizzly bars recited in claim 17 reads on Downey's front bars 45 of grizzly 44. As shown in Figure 4 of Downey, the paddles 23 of the elevator 24 (i.e., conveyor) positively convey material over the front bars 45 to the apex of the grizzly 44. The appellant's assertion that the presence of Downey's rear bars 46 of grizzly 44 prevents the claimed recitation that the conveyor positively conveys material over the grizzly bars from reading on Downey's vehicle is without merit. In this regard, claim 17 is drafted utilizing the transitional phrase "comprising." Therefore, claim 17 is open-ended and does not exclude additional, unrecited elements such as Downey's rear bars 46.

The appellant's argument (brief, p. 7 and reply brief, p. 2) for patentability of claims 32 and 37 is that Bishop

requires a significant length to accommodate the horizontal separation between the grizzly bars 46 and the conveyor belt 30. The appellant then states that the claimed structure provides for a more compact machine with the attendant advantages because the grizzly bar opening is directly over the screen vibrator unit and fines conveyor. We find this argument unpersuasive for the following reasons. First, the claimed second conveyor reads on Bishop's conveyor 26, not conveyor 30 since conveyor 26 receives the fines passing through the screens 18 and 20. Second, as shown in Figures 2 and 3, Bishop's conveyor 26 and screens 18 and 20 are positioned below the opening over which the grizzly bars 46 are mounted. Thus, the claimed subject matter is suggested by the combined teachings of the applied prior art. Lastly, it appears to us that every limitation of claims 32 and 37 is readable on Bishop's machine.³

³ A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

For the reasons set forth above, the decision of the examiner to reject claims 17, 32 and 37 under 35 U.S.C. § 103 is affirmed.

Dependent claims 18 through 24, 33 through 36 and 38 through 41 have not been separately argued by the appellant. Accordingly, these claims will be treated as falling with their parent claims. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the decision of the examiner to reject claims 18 through 24, 33 through 36 and 38 through 41 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 17 through 41 under the judicially created doctrine of double patenting is affirmed, however, for reasons explained supra, we have denominated our affirmance a new ground of rejection under 37 CFR § 1.196(b); the decision of the

examiner to reject claims 25 through 31 under 35 U.S.C. § 112, second paragraph, is affirmed; and the decision of the examiner to reject claims 17 through 24 and 32 through 41 under 35 U.S.C. § 103 is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned

to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 98-1207 - JUDGE NASE
APPLICATION NO. 08/420,648

APJ NASE

APJ FRANKFORT

APJ COHEN

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

DRAFT TYPED: 30 Nov 98

FINAL TYPED: